REMARKS

In the Office Action mailed January 23, 2009, claims 1-8 and 14-21 were rejected under §112, first paragraph; claims 22-29 were rejected under §101 as being directed to non-statutory subject matter; and claims 1-29 were rejected under §103 as being unpatentable over Milillo in view of Asselin and Taylor.

With respect to the §112 rejection of claim 1, the Applicant would like to direct the Examiner's attention to paragraph 29, lines 2-5, which states:

> Next, data updates are transferred from the host application
> 114 to primary PPRC volumes A1-A5 116, respectively, on
> the primary storage control unit 102 and represent a "new"
> consistency group (step 302).

This sentence provides adequate support for the part of claim 1 referenced in the Office Action; reconsideration and withdrawal of the rejection is respectfully requested.

With respect to the §112 rejection of claim 14, the Applicant has corrected the error in an amendment to the claim and the undersigned thanks the Examiner for bringing the error to his attention; reconsideration and withdrawal of the rejection is respectfully requested.

Similarly, the inadvertent omission of the word "storage" in claim 22 has been corrected.

Independent claim 1 has been amended to incorporate claim 4, which has been cancelled, to now recite that the attempt to prepare each FlashCopy source volume for a FlashCopy operation includes generating an Establish-Flash-Copy-revertable command. The Office Action asserts that Taylor (Figure 10: 222 and paragraph 42) teaches this limitation. However, paragraph 42 of Taylor reads:

> When the system backup is complete, the Release
> stage 210 FIG. 5 is performed. The first step 230 is to
> determine if an online backup was requested (and
> presumably performed, although the Release stage is
> performed even if the backup did not take place). If so, then
> the system releases the database from online backup

> preparation, step 222, again which is described in reference to FIG. 10, and the processing is complete, step 214. If an offline backup was requested, then the system releases the database from offline backup preparation, step 228, again which is described in reference to FIG. 8. When that is complete, the processing is complete, step 214.

Thus, the cited step of Taylor occurs only after the backup has been completed. In contrast, the recited step in claim 1 occurs as part of the preparation of each FlashCopy source volume, before the FlashCopy operation is committed or completed. Consequently, claim 1 as amended is not rendered obvious by the cited combination of references. As substantially the same grounds for rejection were asserted against all of the independent claims, the foregoing comments apply equally to those claims, as amended.

The Applicant traverses the rejection of claims 7 and 8 (and their parallel claims in the other claim sets). First, the Applicant would like to highlight the distinction between claims 7 and 8. In claim 7, an attempt is made to prepare one source volume for a FlashCopy operation and then a decision is made as to whether the attempt was successful. Following that decision, an attempt is made to prepare another source volume and a decision is made as to whether the attempt for that source volume was successful. The attempt/decision steps are performed sequentially for each source volume to be FlashCopied. In contrast, in claim 8, attempts are made to prepare all of the source volumes and only then is a decision made as to whether all of the attempts were successful (or, putting it another way, whether any one of the attempts was unsuccessful).

The Office Action asserts that paragraph 40 of Taylor teaches both features. However, paragraph 40 only teaches is that "the system attempts to return to database accessibility" if the backup preparation was not successful. There is no mention of multiple volumes being prepared and there is no mention of when a success/no success decision is made. Nor can it be implied that a decision is made after each attempt to prepare a source volume or that a decision is made after attempts to prepare all

volumes. Taylor is simply silent. Consequently, neither claim 8 nor claim 9 (nor their parallel claims) are rendered obvious by the cited references.

In addition, the Applicant respectfully asserts that the dependent claims are further allowable based on the allowability of the respective independent claims.

For the foregoing reasons, the claims are believed to be allowable, the Application is believed to be in condition for allowance and a favorable Office Action is requested. The Examiner is encouraged to contact the undersigned by telephone if a conversation would expedite prosecution of this case.

This constitutes a request for any needed extension of time. No fee is believed to be due in this instance. The undersigned hereby authorizes the charge of any deficiency of fees submitted herewith, or the credit of any overpayment, to deposit account number 09-0449.

Respectfully Submitted,

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cc: IBM- Tucson